



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,832	04/15/2004	Charles Wu	MSI-347USC1	9462
22801	7590	12/08/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			PATEL, ASHOKKUMAR B	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,832

Applicant(s)

WU, CHARLES

Examiner

Ashok B. Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/23/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-5 are subject to examination.

Response to Arguments

2. Applicant's arguments filed 09/23/05 have been fully considered but they are not persuasive for the following reasons:

Applicant's argument:

Claims 1 and 2,

"Chase does not show or disclose using only one list of corresponding objects that can perform preservation of objects during synchronization even if the list only exists on one of the devices being synchronized.

Examiner's response:

Claim 1 recites "if an object is on the list, then instructing the second computing device to refrain from updating the object when the first computing device cannot access the corresponding object."

Chase teaches in col. 13, line 30-49, "On the desktop C, the tags 216 are implemented as a data structure as part of the data synchronization software that runs on the desktop computer C. These tags 216 point to one of the field mapping table entries 250-252 which contain information about the handheld computer H data as well as the desktop C data for the purpose of creating a mapping between data records. In addition, the desktop tags 216 would need to point to the signature table entries 240-243 containing a signature for each desktop data element to be used during synchronization to determine if the associated data has been modified since the last

synchronization session. This signature structure is used because there is no direct method that informs the desktop tag when data has been changed. Likewise, field-to-field mappings would also need to be constructed since desktop PIMs are likely to support more fields than handheld PIMs. By definition, these mappings also provide a mechanism for filtering out fields allowing more control over what data to share and what data to keep exclusive." Thus Chase teaches "if an object is on the list, then instructing the second computing device to refrain from updating the object when the first computing device cannot access the corresponding object."

Applicant's argument:

Claim 3,

"The Chase reference does not show or disclose listing pairs of corresponding objects and protecting an object and the data items it contains from deletion during synchronization if a corresponding object in a listed pair is unavailable."

Examiner's response:

Claim 3 recites "synchronizing each available pair of objects with new data items from either object in the pair; protecting an object and the data items it contains from deletion during synchronization if a corresponding object in a listed pair is unavailable."

As stated above, Chase teaches in col. 13, line 30-49, "By definition, these mappings also provide a mechanism for filtering out fields allowing more control over what data to share and what data to keep exclusive." Thus Chase teaches synchronizing each available pair of objects with new data items from either object in

Art Unit: 2154

the pair; protecting an object and the data items it contains from deletion during synchronization if a corresponding object in a listed pair is unavailable.

3. Applicant's arguments with respect to claims 4 and 5 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 2154

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3, 4 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12, 18, of U.S. Patent No. 6, 862, 617. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following limitations shown below.

US Patent 6, 862, 617	Instant Application
<p>Claim 1, A method comprising:</p> <p>without input from a user, automatically identifying storage volumes currently accessible to a first device, wherein the storage volumes store objects;</p> <p><u>based on the identification of storage volumes currently accessible to the first device, automatically identifying objects subject to deletion from a second device during a synchronization process to occur between the first device and the second device;</u></p> <p>without input from a user, <u>automatically preventing deletion of the objects subject to deletion during the synchronization process;</u></p> <p>and</p> <p><u>automatically synchronizing only objects contained in the storage volumes currently accessible to the first device.</u></p>	<p>Claim 1, A method of synchronizing objects between two devices when some of the objects are intermittently unavailable on one of the devices, wherein the method prevents the devices from deleting an object when its corresponding object on the other device is unavailable,, comprising:</p> <p>creating a list of the objects to update on a first computing device and a second computing device, wherein the objects on the second computing device are updated using corresponding objects on the first computing device ; and if an object is on the list, then instructing the second computing device to refrain from updating the object when the first computing device cannot access the corresponding object.</p> <p>The obvious limitations are identified as underlined. Please note that Claim 1 of the instant application preamble insists on "<u>the method prevents the devices from deleting an object when its corresponding object on the other device is unavailable</u>" identifying the specific feature of the method of synchronization, thus "Updating" is including "deleting".</p>

<p>Claim 12, A method of synchronizing objects between a portable computer and a base computer, wherein the base computer attempts to delete objects during synchronization if corresponding objects are not accessible to the portable computer, the method comprising:</p> <p><u>storing an object on a removable storage device, wherein the removable storage device is configured to be inserted into and removed from the portable computer;</u></p> <p><u>automatically creating an association between the object and a corresponding object on the base computer;</u> and</p> <p>without user intervention, synchronizing the object stored on the removable storage device with the corresponding object on the base computer if the removable storage device is inserted into the portable computer; and</p> <p>without user intervention, <u>automatically preventing the corresponding object on the base computer from being deleted if the removable storage device is not inserted into the portable computer.</u></p>	<p>Claim 3, a method of maintaining contemporaneous data items within corresponding objects when one of the corresponding objects has new data items wherein the method prevents devices from deleting an object during synchronization when its corresponding object is unavailable, (abstract), comprising:</p> <p>listing pairs of corresponding objects, wherein a first member of each pair resides on a first computing device and a second member of each pair resides on a second computing device; synchronizing each available pair of objects with new data items from either object in the pair; and protecting an object and the data items that it contains from deletion during synchronization if a corresponding object in a listed pair is unavailable.</p> <p>The obvious limitations are identified as underlined. Please note that Claim 1 of the instant application preamble insists on "wherein the method prevents devices from deleting an object during synchronization when its corresponding object is unavailable" identifying the specific feature of the method of synchronization, thus "maintaining contemporaneous data items" is including "deletion" during synchronization.</p>
	<p>Please also refer to the above for claims 4 and 5.</p>

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2154

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated Chase, jr. (US 5, 974. 238).

Referring to claim 1,

Chase teaches a method of synchronizing objects between two devices when some of the objects are intermittently unavailable on one of the devices, wherein the method prevents the devices from deleting an object when its corresponding object on the other device is unavailable,, comprising:

creating a list of the objects to update on a first computing device and a second computing device, wherein the objects on the second computing device are updated using corresponding objects on the first computing device (Abstract); and

if an object is on the list, then instructing the second computing device to refrain from updating the object when the first computing device cannot access the corresponding object. (col. 13, line 30-49, Fig. 5)

Referring to claim 2,

Chase teaches the method as recited in claim 2, further comprising removing the object from the list when the corresponding object is permanently removed from the first device. (Fig. 5, element "delete")

Referring to claim 3,

Art Unit: 2154

Chase teaches a method of maintaining contemporaneous data items within corresponding objects when one of the corresponding objects has new data items wherein the method prevents devices from deleting an object during synchronization when its corresponding object is unavailable, (abstract), comprising: listing pairs of corresponding objects, wherein a first member of each pair resides on a first computing device and a second member of each pair resides on a second computing device; synchronizing each available pair of objects with new data items from either object in the pair; and protecting an object and the data items that it contains from deletion during synchronization if a corresponding object in a listed pair is unavailable. (col. 13, line 30-49, Fig. 5)

Referring to claim 4,

Chase teaches a method of maintaining a contemporaneous corresponding objects on a first and a second device throughout synchronization, wherein the method prevents the devices from deleting an object when its corresponding object is unavailable (Abstract) comprising:

Creating a list of corresponding objects prior to the synchronization (Fig. 5);

During synchronization, determining if an object on the list exists in the first device; if the object does not exist in the first device then determining if the object exists in the second device; and if the object exists in the second device then protecting the object from deletion and allowing the first device to access the object or providing the object to the first device. (col. 13, line 30-49, Fig. 5)

Referring to claim 5,

Art Unit: 2154

Chase teaches a synchronization method for computing devices, wherein the method prevents devices from deleting an object when its corresponding object is unavailable, comprising: creating a list of corresponding objects stored on two computing devices (Fig.5); communicatively coupling the two computing devices for synchronization (Fig. 1F); preventing deletion of the object during synchronization when the corresponding object is unavailable and the object is on the list. ((col. 13, line 30-49)

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2154

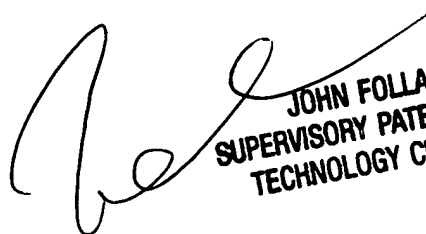
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100